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08/948,328	10/10/97	SIMPSON	D

EXAMINER	
HOOSAIN, A	
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DATE MAILED: 09/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/948,328	Applicant(s) Simpson et al.
	Examiner Allan Hoosain	Group Art Unit 2742

☒ Responsive to communication(s) filed on *4/22/99,6/22/99* .

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-27* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-27* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *4*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

FINAL DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-4,7,9,11-12,14-15,18-20,22-23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by **Judson** (US Patent 5,572,643).

As to Claim 1,9,11-12,14,18-20, with respect to Figures 1-3, **Judson** teaches a computer system comprising:

a server, 14,16, coupled to the Internet (a data communication network), said server being programmed to execute advertisements and downloading sequences of program instructions for:

(a) obtaining advertisements (textual information) for forming messages for a plurality of subscribers, 12,

(b) performing a significant portion of a text to speech process to convert the textual information of at least one of the messages to aural (speech synthesizer) instructions (Col. 6, lines 25-44), and

(c) transmitting the aural (speech synthesizer) instructions over the data communication network (Col. 6, lines 28-35);

and

a subscriber terminal, 12, for receiving the aural (speech synthesizer) instructions via the data communication network, said subscriber terminal, 12, comprising an inherent speech synthesizer for synthesizing an aural information object (speech waveform signal) representing the at least one message from the aural (speech synthesizer) instructions (Col. 6, lines 1-12 and 32-35).

As to Claims 2,22-23,25, in addition to the information above, **Judson** further teaches a computer system as in claim 1, wherein the server includes means for transmitting the aural (speech synthesizer) instructions over the Internet (a packet switched data network) (Col. 1, lines 59-67).

As to Claim 3, in addition to the information above, **Judson** further teaches a computer system as in claim 1, wherein the terminal further comprises a programmable central processing unit and an interface coupled to the programmable central processing unit for communication via the Internet (data network) (Figure 2).

As to Claim 4,15, in addition to the information above, **Judson** further teaches a computer system as in claim 3, wherein the interface comprises a modem (Figure 3, label 50).

As to Claim 7, in addition to the information above, **Judson** further teaches a computer system as in Claim 1, further comprising an e-mail system for receiving e-mail messages for subscribers and supplying the e-mail messages as the textual information to the server for conversion and transmission to the subscriber terminal (Col. 6, lines 26-44).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 5-6, 16-17, 21,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Judson** as applied to claims 4,15,19 above, and further in view of **Wolff et al.** (US Patent 5,327,486).

As to Claim 5-6,16-17,21,24, **Judson** teaches a computer system as in claim 4, wherein the modem comprises a network (Col. 4, lines 33-35). **Judson** does not teach a wireless network. One of ordinary skill would ask what kind of network **Judson's** invention could be used with. **Wolff et al.** teach a lap-top computer which communicates with a wireless network (Figure 1). Since **Judson** and **Wolff et al.** are in analogous network activities, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to add the wireless capability of **Wolff et al.'s** invention to the network capability of **Judson's** invention for a wireless data network modem.

5. Claims 8,10,13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Judson** as applied to claims 1,7,12 above, and further in view of **Meske, Jr. et al.** (US Patent 5,530,852)

As to Claims 8,10,13, **Judson** further teaches a computer system as in claim 7, further comprising a WEB site server but not a news information server. One of ordinary skill practicing Judson's invention would be motivated to ask the question what are the various types of WEB page documents that can be obtained? **Meske, Jr. et al**. teach a server which processes news information documents (**Meske, Jr. et al.**, Col. 6, lines 1-51). Since **Judson** and **Meske, Jr. et al.** are in analogous document retrieving activities, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to add the news source capability of **Meske, Jr. et al.'s** invention to the document capability of Judson's invention for said server being programmed to execute sequences of program instructions for:

storing profile information regarding news topics of interest to individual subscribers;

receiving and storing news items from one or more sources;

comparing the stored news items to the stored profile information to identify news items of interest to each individual subscriber;

addressing mail messages containing text information representing the items of interest to subscribers mail boxes in the mail system; and

transmitting the mail messages containing text information representing the items of interest to the mail system (**Meske, Jr. et al**, Col. 3, lines 45-68).

6. Claims 26-27 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Judson** as applied to claim 14 above, and further in view of **Marsh et al**. (US Patent 5,848,397).

As to Claim 26, **Judson** teaches a communication terminal as recited in Claim 14, wherein said aural instructions (speech synthesizer instructions) are not in the form of MIDI (Musical Instrument Digital Interface). **Judson** teaches that the information object output to the user could be of any type and thereby suggests a MIDI interface (Col. 7, lines 38-43). **Marsh et al**. teach a client computer which can output MIDI information (Col. 14, lines 8-14). Since **Judson** and **Marsh et al**. are in analogous client server activities, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to add the MIDI capability of **Marsh et al.'s** invention to the client capability of **Judson's** invention for a MIDI interface.

As to Claim 27, with respect to Figures 1-3, **Judson** teaches a client server system comprising:

a server coupled to a data communication network, said server being programmed to execute sequences of program instructions for:

(a) obtaining advertisements (textual information) for forming messages for a plurality of subscribers;

(b) performing a significant portion of a text to speech process to convert the textual information of at least one of the messages to html aural instructions (speech synthesizer instructions) but not in the form of MIDI (Musical Instrument Digital Interface) commands, and

(c) transmitting the html aural instructions (speech synthesizer instructions) over the data communication network (Col. 6, lines 28-35); and

a subscriber terminal, 12, for receiving the html aural instructions (speech synthesizer instructions) via the data communication network, said subscriber terminal comprising an inherent speech synthesizer for synthesizing an aural information object (speech waveform signal) representing the at least one message from the html aural instructions (speech synthesizer instructions) (Col. 6, lines 26-44 and Col. 8, lines 3-21).

Judson teaches that the client output can be in any format and thereby suggests a MIDI interface (Col. 7, lines 38-43). **Marsh et al.** teach a client computer which can output MIDI information (Col. 14, lines 8-14). Since **Judson** and **Marsh et al.** are in analogous client server activities, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to add the MIDI capability of **Marsh et al.'s** invention to the client capability of **Judson's** invention for a MIDI interface.

Response to Arguments

7. Applicant's arguments filed 6/29/99 have been fully considered but they are not persuasive because of the following:

(a) Applicants argue that no teaching has been found in **Judson** (or the other cited references) of performing some text to speech conversion at a server and transmitting the result with speech synthesizer instructions to the subscriber terminal to complete the synthesis process.

Examiner respectfully disagrees because **Judson** teaches that the server transmits a web page with aural html instructions and that some or all of the web page could be aural. Examiner believes that the aural html instructions are text to speech instructions provided by the server

(Col. 5, lines 40-49 and Col. 6, lines 26-44). In addition, the **Meske, Jr. et al.** reference teach the parsing of information at the server and thereby suggests a speech synthesizer function at a server (Col. 5, lines 58-67).

(b) Applicants argue that it is submitted that the Office Action holding that the **Judson** subscriber terminal inherently includes a speech synthesizer, without a disclosure thereof in the patent, is based on improper hindsight consideration of the present disclosure.

Examiner respectfully disagrees because as Examiner pointed out in the Office Action the aural instructions are in an information object. The only way this information object can be converted into speech is for some type of text to speech conversion process to be present. Since, **Judson** teaches that the information is output aurally, then this suggests that the user's computer has an inherent speech synthesizer (see also, Col. 8, lines 3-12).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Engberg et al. (US Patent 5,283,638) teach a workstation with a MIDI interface.

Goetz et al. (US Patent 5,928,330) teach a client server system which organizes multimedia information for client users.

Mighdoll et al. (US Patent 5,918,013) teach a system and method for transcoding documents for client users.

Eller et al. (US Patent 5,889,860) teach a computer system for retrieving music information from servers.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 308-5403 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

11.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Krista Zele**, can be reached on (703) 305-4701.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Allan Hoosain AH

Patent Examiner

September 9, 1999

FAN S. TSANG
PRIMARY EXAMINER